



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/529,267

09/29/2005

Valerie De La Poterie

05725.1445

4347

22852

7590

06/24/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

SIMMONS WILLIS, TRACEY A

ART UNIT

PAPER NUMBER

1619

MAIL DATE

DELIVERY MODE

06/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,267	Applicant(s) DE LA POTERIE ET AL.	
	Examiner TRACEY SIMMONS WILLIS	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 87-189 is/are pending in the application.
- 4a) Of the above claim(s) 178-189 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 87-177 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02202007; 05242007; 05072009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

Applicant's election with traverse of Group I including claims 87-177 in the reply filed on April 17, 2009 is acknowledged. The traversal is on the ground(s) that USPN 6,805,872 does not teach the invention. This is not found persuasive because the inventions were shown to lack a special technical feature over prior art was established in accordance with 37 CFR 1.499.

The requirement is still deemed proper and is therefore made FINAL.

Examiner is withdrawing the species election. Claims 87-189 are pending in the current application, of which claims 87-177 are being considered on their merits. Claims 178-189 are withdrawn from consideration at this time. This is the first Action on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 87-88, 90-98, 102-111, 113-114, 138-148, 150-151, 161-162, 167, and 175-177 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pre-grant Publication 2002/0155780 (Mougin).

Mougin teaches of the use of film-forming block ethylenic copolymers to improve the staying power of a make-up composition [pg 1, par 12]. Acceptable solvents for the polymers include ethanol (water-miscible organic solvent) [pg 4, par 100]. The concentration of the

Art Unit: 1619

polymers in the composition ranges from 1-99% [pg 4, par 100]. The block copolymers have a rigid reason with a glass transition temperature (Tg) of greater than or equal to 20 °C and one flexible block with a Tg of less than or equal to 20 °C [pg 1, par 12]. In one embodiment, the block copolymer is poly(methyl methacrylate-b-butyl acrylate-b-methyl methacrylate [pg 6, Example 2] in which the Tg of the first block is 70 °C and the Tg of the second block is -47 °C, with a number-average molar mass is 51,900 [pg 6, par 144]. The first block is present in range of 10-60% [pg 3, par 45]. The solution is applied to nails as a varnish [pg 6, par 149]. The blocks used in the copolymers are of homopolymeric type [pg 2, par 38]. As the composition and copolymer is taught by the prior art, the property of polydispersion index is an inherent property of the copolymer and cannot be separated from the composition. The embodiment does not contain wax. Mougin anticipates the instantly claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 87-88, 90-98, 102-111, 113-114, 138-148, 150-153, 156, 159-164, 168, and 173-177 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pre-grant Publication 2002/0115780 (Mougin).

Mougin teaches of the use of film-forming block ethylenic copolymers to improve the staying power of a make-up composition [pg 1, par 12]. Acceptable solvents for the polymers

Art Unit: 1619

include ethanol (water-miscible solvent) [pg 4, par 100]. The concentration of the polymers in the composition ranges from 1-99% [pg 4, par 100]. The block copolymers have a rigid reason with a glass transition temperature (T_g) of greater than or equal to 20 °C and one flexible block with a T_g of less than or equal to 20 °C [pg 1, par 12]. In one embodiment, the block copolymer is poly(methyl methacrylate-b-butyl acrylate-b-methyl methacrylate [pg 6, Example 2] in which the T_g of the first block is 70 °C and the T_g of the second block is -47 °C, with a number-average molar mass is 51,900 [pg 6, par 144]. The first block is present in range of 10-60% [pg 3, par 45]. The solution is applied to nails as a varnish [pg 6, par 149]. The blocks used in the copolymers are of homopolymeric type [pg 2, par 38].

The polybutyl acrylate block is a linear unsubstituted alkyl C₄ polymer. *claims 97-98, and 111* The polymethylmethacrylate block is a linear alkyl C₁ polymer. *claims 94-95, 105-106, and 138*

Mougin does not teach of an embodiment with volatile or nonvolatile oils, the recited amount of solvent, a wax, an additional film-forming polymer, fillers, or specifically of a mascara.

Mougin further teaches that the composition can also contain volatile and/or nonvolatile oils [pg 5, par 115], waxes [pg 5, par 118], fillers [pg 5, par 125], and can be formulated as a mascara [pg 6, par 131].

One of ordinary skill in the art at the time of the invention would have been motivated to add volatile and nonvolatile oils, and waxes to the composition to soften the skin (make-up) or hair, and fillers to add rigidity and uniformity to the composition with a reasonable expectation of success as these additional components are commonly found in cosmetic compositions.

Art Unit: 1619

The polydispersion index as recited is determined to be an expected property of the composition, absent evidence to the contrary. The U.S. Patent Office is not equipped with analytical instruments to test prior art compositions for the infinite number of ways that a subsequent applicant may present previously unmeasured characteristics. When as here, the prior art appears to contain the exact same ingredients and applicant's own disclosure supports the suitability of the prior art composition as the inventive composition component, the burden is properly shifted to applicant to show otherwise.

Claims 89, 99-101, 112, 115-133, 135-137, 154-158, and 164-166 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mougin as applied to claims 87-88, 90-98, 102-111, 113-114, 138-148, 150-153, 156, 159-160, 162-164, 168, and 173-177, above and further in view of U.S. Patent 6,153,206 (2000, Anton et al).

The teachings of Mougin are relied upon above.

Mougin does not teach of the amounts of oils and wax in the composition or of a monomer block with a Tg between 20 and 40 °C.

Anton teaches of 0.1-60% non-elastomeric film-forming polymers with first and second ethylenically unsaturated units (block copolymers) used in cosmetic compositions [col 2, line 59 and col 3, lines 25 and 46]. The compositions can also include volatile or non-volatile oils in amounts of 1-50% [col 8, lines 51-53] and preferably contain 1-70% wax [col 9, lines 42-43]. Other monomers that can be used in the copolymer include propylmethacrylate (Tg = 35 °C) [col 5, line 45].

Art Unit: 1619

The polybutyl acrylate block is a linear unsubstituted alkyl C₄ polymer. *claim 129* The polymethylmethacrylate block is a linear alkyl C₁ polymer. *claims 123-124* The intermediate block comprising the constituent blocks of the first and second blocks would be an inherent feature of block copolymers for an intermediate block to contain portions of each of the first and second blocks. The intermediate block would constitute an additional monomer for the first or second monomer.

One of ordinary skill in the art at the time of the invention would have been motivated to optimize the amounts of oils and wax in the composition to effectively provide softness to the skin (make-up). One of ordinary skill in the art would have been motivated to use the monomers of varying Tgs as taught by Anton with a reasonable expectation of success as the copolymer of Mougin teaches block monomers with varying Tg values.

Claims 115, 133-134, 149 and 172 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mougin as applied to claims 87-88, 90-98, 102-111, 113-114, 138-148, 150-153, 156, 159-160, 162-164, 168, and 173-177, above and further in view of U.S. Patent 6,410,005 (2002, Galleguillos et al).

The teachings of Mougin are relied upon above.

Mougin does not teach of surfactants or of the solubility without adjustment of pH or of hydrophilic blocks.

Galleguillos teaches of hair styling composition comprising block copolymers with varying glass transition temperatures with hydrophilic and hydrophobic blocks in organic

Art Unit: 1619

solvents and with surfactants [col 3, lines 31-32, 42-45, and 63]. The copolymers can be dissolved in water upon pH adjustment [col 12, lines 9-11].

One of ordinary skill in the art at the time of the invention would have been motivated to use the surfactant in the composition of Mougin with a reasonable expectation of success as surfactants are commonly used as emulsifiers in cosmetics.

One of ordinary skill in the art would have been motivated to use hydrophilic monomers in the copolymer of Mougin as the monomers have varying Tgs and the hydrophilic monomers would provide greater ease of dispersion of the copolymer [col 4, lines 34-36].

Claims 168-171 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mougin as applied to claims 87-88, 90-98, 102-111, 113-114, 138-148, 150-153, 156, 159-160, 162-164, 168, and 173-177, above and further in view of U.S. Patent 6,464,969 (2002, de la Poterie et al).

The teachings of Mougin are relied upon above.

Mougin teaches of one or more additional film-forming polymers [pg 5, par 121], but does not teach of the recited limitations related to the additional polymer.

De la Poterie teaches of a composition comprising at least one hydrophobic film-forming and a thermal transition agent [col 4, lines 30-34] which can be one and the same polymer as an aqueous dispersion [col 7, line 9] from 0.1-30% [col 4, line 25].

One of ordinary skill in the art at the time of invention would have been motivated to add the additional film-forming polymer to the invention of Mougin with a reasonable expectation of

Art Unit: 1619

success to increase the adhesion of the cosmetic (make-up) to the skin and limit transfer (rub-off) [col 2, lines 4-8].

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRACEY SIMMONS WILLIS whose telephone number is (571)270-5861. The examiner can normally be reached on Mondays to Fridays from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. S.W./
Examiner, Art Unit 1619

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615